

**REMARKS**

The Examiner is thanked for the careful review of this application.

Claims 1-32 were previously pending in the present application. In the above amendments, claims 1, 7, 11, 15, 19, 21, 22, 24, 25, 27, 28, 31, and 32 have been amended, and new claims 33-42 have been added. Support for these amendments may be found throughout the Specification. *See, e.g.*, Specification, paragraphs 0031, 0035, 0036, and 0043. Therefore, after entry of the above amendments, claims 1-42 will be pending in this application.

The Applicants believe that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

***Rejection under 35 USC § 101***

The Office has rejected claim 1 under 35 USC § 101 as being directed to non-statutory subject matter. As the Office has recommended, the Applicants have amended claim 1 to recite that the “providing” occurs at a server, in order to identify the apparatus performing the action. This amendment is supported throughout the Specification. Thus, Applicants respectfully request that the Office withdraw the rejection of claim 1 under 35 USC § 101.

***Rejection under 35 USC § 103(a)***

The Office has rejected claims 1-32 under 35 USC § 103(a) as being obvious over Mikurak (US 6,606,744) in view of Reed (US 6,757,710). The Applicants respectfully traverse this rejection.

Independent claims 1, 7, 11, 15, and 19 are patentable over the cited prior art, as any combination of Mikurak and Reed fails to disclose or suggest a method, system, or computer-readable medium including, at least, the recited subject matter of: (i) billing-related metadata relating to how to account for distribution of the application by a receiver entity/carrier to a wireless device operable on a network of the receiver entity/carrier and corresponding to a subscriber; and (ii) and transmitting billing information only to the receiver entity/carrier, or generating billing information for transmission only to the receiver entity/carrier, to account for a transaction involving the application, the wireless device and the receiver entity, or to account for the distribution of the application by the carrier to the wireless device, wherein the billing information includes a developer payment fee and a portion of the transaction data operable by the receiver entity/carrier to derive an application download event for billing the subscriber.

To establish a *prima facie* case of obviousness, all of the claimed features must be taught or suggested by the references and there must be some suggestion or motivation, in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* MPEP, section 2142.

In the Office Action, the Office states that Mikurak discloses billing-related metadata relating to how to account for distribution of the application by the receiver entity to a wireless device operable on a network of the receiver entity and corresponding to a subscriber. The Applicants respectfully disagree, as Mikurak is silent with respect to this subject matter. In particular, the relevant cited portions of Mikurak relate to electronic agreements between value chain participants. Mikurak, cols. 118 and 119. However, there is no disclosure or suggestion of billing-related metadata, agreed-to by a delivery entity/developer and a receiver entity/carrier, relating to how to account for distribution of an application by a receiver entity/carrier to a wireless device operable on a network of the receiver entity/carrier and corresponding to a subscriber, as recited.

Moreover, Mikurak is likewise silent with respect to transmitting billing information only to the receiver entity/carrier, or generating billing information for transmission only to the receiver entity/carrier, to account for a transaction involving the application, the wireless device and the receiver entity, or to account for the distribution of the application by the carrier to the wireless device, wherein the billing information includes a developer payment fee and a portion of the transaction data operable by the receiver entity/carrier to derive an application download event for billing the subscriber, as recited. Rather, Mikurak generally discusses an interface between various participants in a value chain. Mikurak, however, does not disclose or suggest the recited billing information only for transmission to the receiver entity/carrier, which can account for the transaction or distribution, as recited. Thus, Mikurak fails to teach or suggest all of the recited subject matter.

Further, the addition of Reed fails to make up for the deficiencies of Mikurak, as Reed also fails to disclose or suggest the recited subject matter. Reed discloses updating information between computers; however, Reed does not disclose or suggest the recited billing-related metadata. Nor does Reed disclose or suggest the recited generating or transmitting of the billing information only for the receiver entity/carrier to account for the distribution of the application by the receiver entity/carrier to the wireless device. Thus, in any combination, Mikurak and

Reed fail to disclose or suggest all of the recited subject matter of independent claims 1, 7, 11, 15, and 19.

Additionally, claims 2-6, 8-10, 12-14, 16-18 and 20-32 depend from one of independent claims 1, 7, 11, or 15, and thus are allowable over the cited prior art for at least the same reasons. Further, each of these claims separately recites a combination of subject matter that is not disclosed or suggested by any combination of the prior art.

For example, referring to claims 21, 22, 24, 25, 27, 28, 31, and 32, there is no combination of Mikurak and Reed that discloses or suggests the recited catalog including the correspondence between the application and the agreed-to billing-related metadata in combination with the above-recited subject matter of the respective independent claim.

Similarly, with regard to independent claim 19, there is no combination of Mikurak and Reed that discloses or suggests the recited catalog including the correspondence between the application and the agreed-to billing-related metadata in combination with the above-recited subject matter of independent claim 19.

Therefore, based on the foregoing remarks, the Applicants respectfully request that the Office withdraw the rejection of claims 1-32 under 35 USC § 103(a) as being obvious over Mikurak in view of Reed.

### ***New Claims***

The Applicants have added new claims 33-42 to recite subject matter to which they are entitled. As noted above, these new claims are fully supported throughout the Specification.

Additionally, claims 33-42 are allowable, as there is no combination of the cited references that discloses or suggests the subject matter recited by these claims. In particular, claims 33-42 respectively depend from one of independent claims 1, 7, 11, 15, or 19, which are believed to be patentable over any combination of the cited references, as discussed above. Thus, for at least the same reasons, claims 33-42 are also non-obvious and patentably distinguishable over the cited prior art references. See MPEP 2143.03.

Further, each of these claims separately recites subject matter not disclosed or suggested by any combination of the cited references.

For example, referring to claims 33, 35, 37, 39, and 41, there is no combination of the cited references that discloses or suggests a method, system, or computer-readable medium that includes actions of, means or instructions for, or a server operable in forwarding a developer

payment to the delivery entity based on the transaction data and on the agreed-to billing-related metadata, and including an enablement fee with the billing information.

Also, for example, referring to claims 34, 36, 38, 40, and 42, there is no combination of the cited references that discloses or suggests a method, system, or computer-readable medium that includes actions of, means or instructions for, or a server operable in determining, prior to transmitting billing information, that the transaction includes the wireless device billing event based on the received transaction data and previously-stored application-related information for the wireless device.

Therefore, Applicants respectfully request that the Office allow claims 33-42.

## CONCLUSION

In light of the amendments contained herein, the Applicants respectfully submit that the application is in condition for allowance, for which early action is requested. Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, then the Examiner is invited to contact the Applicants' undersigned representative at the telephone number below.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated October 16, 2008

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